

+The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. EDWARD CICHANOWICZ

Appeal No. 2005-0962
Application 09/839,245

ON BRIEF

Before JERRY SMITH, LEVY, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-8 and 13-20. Claims 9-12 have been withdrawn.



Invention

Appellant's invention relates to a method to provide for an interactive on-line system for evaluating the performance of engineered systems or equipment that utilize non-commodity materials or items, using a network of database (that may be either inherent to the present system or provided by a third party) that describe the features and characteristics of these materials and items, ultimately supporting the procurement of the most optimal materials or items. In essence, the inventive system comprises an "intelligent exchange," in which key decision-support tools are provided that enable the selection of the optimal material or item for the design or process. Appellant's specification at page 5, lines 2-12.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An automated method for conducting buy and sell transactions over a network for a non-commodity material or item that can have differing chemical and physical and/or electrical characteristics, comprising:

a plurality of sellers each providing to the network physical and chemical and/or electrical characteristics via at least one computer of a quantity of the non-commodity available for sale and a cost of the available non-commodity, creating a database of the non-commodity including the different physical and chemical characteristics for each non-commodity available;

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a buyer providing to the network a performance simulation model of a chemical, mechanical, or electrical process with equipment currently in operation or intended to be in operation and with a desired amount of the non-commodity for use in the process, the performance simulation model being able to estimate the production cost and operation characteristics of the process based on chemical and physical and/or electrical characteristics of a non-commodity material or item used in the process;

the buyer also providing a desired maximum cost of operating the process, or maximum production cost of material or goods resulting from the process, or desired operating characteristics of the process that are dependent upon the non-commodity material or item; and

estimating the cost of operating the process or producing goods from the process for at least some of the different non-commodities from the database of different non-commodities in the performance model to make a comparison of the at least some of the different non-commodities to determine which, if any, of the at least some of the different non-commodities are within the maximum process cost;

providing the buyer with a list of non-commodities that when used as input for the process are within the desired maximum process production or operating cost, or provide certain operating characteristics;

utilizing a database and standard datamining techniques to record performance of the process with a selected non-commodity item, and applying this information in the formulation of a request-for-proposal for future purchases of non-commodity materials or items.

References

The references relied on by the Examiner are as follows:

Vandivier, III	5,033,004	Jul. 16, 1991
Katz et al. (Katz)	5,224,034	Jun. 29, 1993

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Rejections At Issue

Claims 1-8 and 13-20 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Katz and Vandivier.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-8 and 13-20 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

¹Appellant filed an appeal brief on July 6, 2004. Appellant filed a reply brief on November 15, 2004. The Examiner mailed an Examiner's Answer on September 16, 2004.

Appellant has indicated that for purposes of this appeal the claims stand or fall together. See page 3 of the brief. We will, thereby, consider Appellant's claims as standing or falling together, and we will treat claim 1 as a representative claim.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-8 and 13-20. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellant argues at page 6 of the brief, "in Katz, a quantity of a non-commodity is never provided to a network." The Examiner responds at page 8 of the answer, "Katz does teach a plurality of sellers providing information including a quantity available for use on a computer system." We find Appellant's position to be the better.

We have reviewed the Katz patent and contrary to the Examiner's position in the final rejection (paper no. 7), we do not find "a quantity of a non-commodity" as alleged by the Examiner.

Appellant argues at page 7 of the brief, "neither [reference] 'make a comparison . . .'" as required by the present claims. The Examiner responds that Official Notice was used as to this maximum process cost feature. We have reviewed the final

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rejection and although there are several instances of Official Notice, we do not find one that corresponds to maximum process cost. Again, we find Appellant's position to be the better.

As to Appellant's other arguments at pages 7-9 of the brief, we find them persuasive for the reasons set forth by Appellant.

Finally, we note that the Examiner has failed to meet the initial burden of establishing a **prima facie** case of obviousness. In our review of the Examiner's final rejection (paper no. 7) we find that the Examiner has failed to point to concrete evidence in the record in support of the Examiner's findings. For example, pages 3 and 4 of the final rejection fail to indicate where any of the alleged features are found in the references. We do not choose to guess what parts of the references the Examiner believes teach the various claim limitations.

Therefore, for the above reasons, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

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Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-8 and 13-20.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

STUART S. LEVY

STUART S. LEVY
Administrative Patent Judge

Allen K. Markon

ALLEN R. MACDONALD
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